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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,898	06/27/2003	William A. Groll	916-030481	7789

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EXAMINER	
ZIMMERMAN, JOHN J	

ART UNIT	PAPER NUMBER
1775	

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/608,898	GROLL, WILLIAM A.	
	Examiner	Art Unit	
	John J. Zimmerman	1775	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-12* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *3 and 5* is/are allowed.

6)☒ Claim(s) *1,2,4,6,7 and 10-12* is/are rejected.

7)☒ Claim(s) *8 and 9* is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *6/27/03* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *20031128*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

FIRST OFFICE ACTION

Information Disclosure Statement

1. The Information Disclosure Statement received November 28, 2003 has been considered. An initialed form PTO-1449 is enclosed with this Office Action.

Claim Objections

2. Claim 7 is objected to because of the following informalities: The spelling of "conductivity" should be corrected in claim 7, line 3.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
>
> (e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

4. Claims 1-2, 4, 6-7 and 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Stein (U.S. Patent 3,340,597).

5. Stein discloses a multilayered composite sheet made from a plurality of roll bonded layers including an inner layer of a lower coefficient of thermal conductivity material (304 type stainless steel) between layers of higher coefficient of thermal conductivity materials (e.g. 3004 type aluminum). A heating temperature step includes ranges between 500-975°F (e.g. see column 3, lines 34-46) and includes cleaning steps to remove oxide surfaces (e.g. column 2, lines 50-57). The composite sheet is useful for making cookware (e.g. see column 2, lines 33-44). Specific example shows an aluminum/stainless/aluminum composite (column 5, lines 5-22) and other specific alloys are disclosed (e.g. see column 2, lines 5-32). Regarding the forming step of claim 11, Stein's disclosure of that the composite sheet is to made into cookware provides sufficient specificity for the step of forming the composite sheet into cookware. Regarding the distribution of heat in a lateral direction, the ability to laterally distribute heat would be inherent to the materials and construction of the composite sheet. Since the materials and construction are the same as those claimed by applicant the distribution of heat would be expected to be the same. Discovery of a new property or use of previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to known composition, *In re Spada*, 15 USPQ2d 1655 (Court of Appeals, Federal Circuit 1990). Patent and Trademark Office can

require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977).

6. Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Racz (U.S. Patent 3,788,513).

7. Racz discloses a multilayered composite sheet made from a plurality of clad layers including an inner layer of a lower coefficient of thermal conductivity material (steel) between layers of higher coefficient of thermal conductivity materials (e.g. aluminum). The lower coefficient of thermal conductivity layer is specifically intended by Racz to reduce hot spots at the bottom of the cookware by causing lateral conduction (e.g. see column 6, lines 22-50). The composite sheet is useful for making cookware (e.g. see Figures 1-2) and may be coated with a non-stick material (e.g. see column 4, lines 44-49). Regarding the recitation of "roll bonded", when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

8. Claims 1-2 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by McCoy (U.S. Patent 3,966,426), Ulam (U.S. Patent 4,646,935), Spring (U.S. Patent 5,952,112) or Okato (U.S. Patent 5,532,460).

9. McCoy (e.g. see Figure 3) discloses a multilayered composite sheet made from a plurality of layers including an inner layer of a lower coefficient of thermal conductivity material (e.g. 304 type stainless steel) between layers of higher coefficient of thermal conductivity materials (e.g. aluminum). The composite sheet is useful for making cookware (e.g. see Figure 1) and may include a non-stick coating (e.g. column 5, lines 51-52). Ulam (e.g. see Figure 3) discloses a multilayered composite sheet made from a plurality of layers including an inner layer of a lower coefficient of thermal conductivity material (e.g. stainless steel) between layers of higher coefficient of thermal conductivity materials (e.g. aluminum). The composite sheet is useful for making cookware (e.g. see Figure 1). Spring (e.g. see Figure 6) discloses a multilayered composite sheet made from a plurality of layers including an inner layer of a lower coefficient of thermal conductivity material (e.g. stainless steel) between layers of higher coefficient of thermal conductivity materials (e.g. aluminum). The composite sheet is useful for making cookware (e.g. see Figure 1). Okato (e.g. see Table 1, examples 8 and 9) discloses a multilayered composite sheet made from a plurality of layers including an inner layer of a lower coefficient of thermal conductivity material (e.g. TiAlSnZrMoSi) between layers of higher coefficient of thermal conductivity materials (e.g. TiAlV). The composite sheet is useful for making cookware (e.g. see claim 1). Regarding the distribution of heat in a lateral direction in the

references, the ability to laterally distribute heat would be inherent to the materials and construction of the composite sheet. Since the materials and construction are the same as those claimed by applicant the distribution of heat would be expected to be the same. Discovery of a new property or use of previously known composition, even if unobvious from the prior art, cannot impart patentability to claims to known composition, *In re Spada*, 15 USPQ2d 1655 (Court of Appeals, Federal Circuit 1990). Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). Regarding the recitation of "roll bonded", when there is a substantially similar product, as in the applied prior art, the burden of proof is shifted to the applicant to establish that their product is patentably distinct not the examiner to show that the same process of making, see *In re Brown*, 173 U.S.P.Q 685, and *In re Fessmann*, 180 U.S.P.Q. 324.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stein (U.S. Patent 3,340,597) in view of applicant's disclosure of the prior art.

12. Stein is discussed above. Stein may differ from claim 12 in that Stein may not disclose a step of applying a non-stick layer to the cook surface of his cookware. Applicant, however, admits that it is well known in the art to provide cook surfaces with non-stick layers (e.g. see paragraph [0004] of the specification). It is generally understood in the cooking art that non-stick coatings allow a cook to use less oil and also allows for easier cleanup. It must be assumed that one of ordinary skill in a particular art understands the basic concepts in that art. In view of applicant's disclosure of the prior art, it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply a non-stick surface to the cookware of Stein because it is generally understood that non-stick surfaces on cookware allow for cooking with less oil and also provide for easier cleanup of the cookware.

13. Claims 6 and 11-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Racz (U.S. Patent 3,788,513) in view of Stein (U.S. Patent 3,340,597).

14. Racz discloses a multilayered composite sheet made from a plurality of clad layers including an inner layer of a lower coefficient of thermal conductivity material (steel) between layers of higher coefficient of thermal conductivity materials (e.g. aluminum). The lower

coefficient of thermal conductivity layer is specifically intended by Racz to reduce hot spots at the bottom of the cookware by causing lateral conduction (e.g. see column 6, lines 22-50). The composite sheet is useful for making cookware (e.g. see Figures 1-2) and may be coated with a non-stick material (e.g. see column 4, lines 44-49). Racz may differ from the pending method claims in that while Racz does disclose that his composite can be made by cladding (e.g. see column 5, lines 24-36), Racz may not disclose the individual conventional steps of preparing the sheets by removing oxide surfaces, stacking, heating and rolling. Stein, however, shows that when making clad cookware, one should prepare the sheets by removing oxide surfaces, stack, heat and roll bond the multilayer composite (e.g. see examples 1-5 of Stein). In view of Stein, it would have been obvious to one of ordinary skill in the art to prepare the sheets of Racz by removing oxide surfaces, stacking, heating and roll bonding the multilayer composite because Racz does not give details of the cladding process used in making his cookware and Stein supplies details of how to clad metal layers when making multilayer composite cookware.

Allowable Subject Matter

15. Claims 3 and 5 are allowed. Claims 8 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The prior art of record does not anticipate or make obvious the combination of materials in the manners required by these claims.

Conclusion

16. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The additionally cited prior art serves to further establish the level of ordinary skill in the art at the time the invention was made.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John J. Zimmerman whose telephone number is (571) 272-1547. The examiner can normally be reached on 8:30am-5:00pm, M-F. Supervisor Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

John J. Zimmerman
Primary Examiner
Art Unit 1775

jjz
February 24, 2004